

#### REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 2, 4-6, 8, 9 and 31 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1, 2, 4-6, 8-12, 14-19 and 22-31 remain pending in this application.

#### **Rejection under 35 U.S.C § 101**

Claims 1, 2, 4-6, 8, 9 and 31 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant has amended the claims as suggested by the Examiner. Therefore, claims 22-26, 34 and 35 are directed to statutory subject matter, and the rejection under 35 U.S.C. § 101 should now be withdrawn.

#### **Rejection under 35 U.S.C § 103**

Claims 1, 2, 4-6, 8-12, 14-19 and 22-31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,657,658 to Takemura (hereinafter “Takemura”) in view of U.S. Patent No. 6,650,365 to Sato (hereinafter “Sato”). Applicant respectfully traverses this rejection for at least the following reasons.

In response to the Examiner’s earlier rejections, Applicant amended each of independent claims 1, 10, 18 and 31 to recite that the “most recent information” regarding/indicative of “adjustments”/“modifications” is “stored within a lossy format comment field.” As an example of this feature, reference may be made to Figure 2 of the present application. As illustrated in Figure 2, a lossy format (e.g., JPEG) has a comment field 22. In accordance with the pending claims, the most recent information may be stored in the comment field of the lossy format (e.g., JPEG).

As previously noted by Applicant, the combination of Takemura and Sato fails to render the claims obvious. Takemura fails to teach or suggest any use of a lossy format file and actually contemplates the creation/defining of a “new” file format. Thus, while Sato may evidence an exemplary type of lossy format file which can be used to store media data, nothing in either reference suggests the use of a comment field in that lossy format file to store such adjustment/modification information.

In the “Response to Arguments” section of the pending office action, the Examiner merely reiterates his position that Takemura discloses defining a file format including both the image data and the finish information, while Sato discloses a lossy format. Even if the Examiner’s interpretation of the disclosures of Takemura and Sato are accepted, the Examiner fails to provide any evidence of motivation for one of ordinary skill in the art to combine the teachings of Takemura and Sato to achieve the claimed invention.

M.P.E.P. § 706.02(j) is clear that the initial burden is on the Examiner “to provide some suggestion of the desirability of doing what the inventor has done.” It is not enough simply to identify the existence of missing elements in secondary references. The Examiner also has the burden of establishing a motivation for making the suggested combination. In this case, however, as described above, none of the cited prior art references provides any motivation for making the suggested combination. Further, the Examiner fails to provide any evidence that one of ordinary skill in the art would be motivated to make the suggested combination. Therefore, the cited references fail to render the claims obvious.

Therefore, pending independent claims 1, 10, 18 and 31 are patentable. Further, claims 2, 4-6, 8, 9, 11, 12, 14-, 17, 19 and 22-30 each depend from one of allowable claims 1, 10 or 18 and are, therefore, patentable for at least that reason, as well as for additional patentable features when those claims are considered as a whole.

### **Conclusion**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-5302. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-5302. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-5302.

Respectfully submitted,

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